

REMARKS

This amendment is filed in response to the Office Action dated June 4, 2003. Claims 1-7, 10-14 and 18-32 are pending. In the Office Action of June 4, 2003, the Examiner finally rejected claims 1, 3-5, 7, 18-21, 23 and 25-31 under 35 U.S.C. § 103(a) as being unpatentable over Liao et al., U.S. Patent No. 6,292,833 ("Liao") in view of Shefi, U.S. Patent No. 6,445,794; finally rejected claims 6, 10-12, 14, 22 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Liao and Shefi in view of Zicker et al., U.S. Patent 5,862,475 ("Zicker"); finally rejected claim 13 under 35 U.S.C. § 103(a) as being unpatentable over Liao and Shefi; and finally rejected claim 32 under 35 U.S.C. § 103(a) over Liao and Shefi in view of Galvin, U.S. Patent No. 6,134,315.

By this amendment, claims 1, 3, 4, 18, 20, 21, and 25 are amended to more particularly and distinctly claim the invention. In particular, the independent claims 1, 4, 18 and 25 are amended to clearly indicate that the link at issue is a "link that does not send or receive private or encrypted information or that uses facilities not absolutely controlled by a network provider." The dependent claims are amended to conform to the amendment of the independent claims. Support for the amendment of the claims is found throughout the specification and drawings, and in particular, in the specification, at page 2, lines 3 through 5. The Examiner's rejections are traversed below in light of the amended claims.

Claims 1, 3-5, 7, 18-21, 23 and 25-31 Are Patentable Over Liao And Shefi

The Examiner rejected claims 1, 3-5, 7, 18-21, 23 and 25-31 under 35 U.S.C. 103(a) as being unpatentable over Liao in view of Shefi. The Applicants respectfully traverse the rejection with respect to claims 1, 3-5, 7, 18-21, 23 and 25-31 on the bases that (1) these claims, as amended, include certain novel limitations that are not

disclosed by Liao or Shefi, separately or in combination; and (2) the claim are not obvious because there is no motivation to combine Shefi and Liao.

In particular, as discussed further below, Liao and Shefi fail to disclose a means or method for a person, e.g., a called party, calling party, or user of a customer premise equipment, to be alerted to the particular security status specified in the claims. As amended, claims 1, 4, 18 and 25 alert a user if a transmission is received over a link "that does not send or receive private or encrypted information or that uses facilities not absolutely controlled by a network provider." That is, the particular security status not only relates to encryption, must also consider whether private, e.g., circuit-switched, information is transmitted or whether the link uses a facility not absolutely controlled by a network provider.

In the prior response the Applicants argued that Shefi did not disclose alerting a called party, calling party or user to the security status of a communications link. In the final office action the Examiner expressed his disagreement with this position. While the Applicants do not concede that Shefi makes the required disclosure in light of the definition of "secure" in Shefi¹, the claims are amended to be patentable over Shefi, even under this broad interpretation by the Examiner. In particular, Shefi does not disclose determining whether a non-private communication is occurring, nor whether the facilities are absolutely controlled by a network provider.

Since Shefi and Liao fail to disclose alerting a user to receipt of a transmission over a link that is non-encrypted and non-private or not under absolute control, the claims are patentable.

¹ Shefi explicitly defines "non-secure" in the patent specification as merely reflecting whether the invention disclosed in Shefi is used or not, not as reflecting actual security status. See, Shefi, column 9, lines 12-21 ("term 'non-secure' is not intended to indicate the actual security quality ... but only to indicate that the device or protocol is not of the present invention").

In addition, and alternatively, as discussed in the prior response, there is no motivation to combine Liao and Shefi. Shefi avoids the consequences of using insecure links by encrypting. Therefore, one of ordinary skill in the art would not combine Liao with Shefi. Liao does not even recognize the problem or solution of concern in the present invention, namely, allowing a user to prevent insecure communications when secure communications are desired. Therefore, independent claims 1, 4, 18 and 25, which each require an alert of a status of a route, call path, or link to a person, are not obvious in view of Shefi and Liao. The dependent claims 3, 5-14, 19-24 and 26-32 depend ultimately from one of the independent claims, and are patentable for at least the reasons given above for the independent claims.

In the final office action the Examiner recognizes that there must be some motivation for combining reference for an obviousness rejection. But the Examiner fails to set forth any motivation for the combination of Liao and Shefi. The Examiner merely states that "the combine [sic] of Liao and Shefi teach a user receive the security status of a communications link and make further decisions." This statement does not set forth the motivation to combine, but merely states what the combination purports to teach. There is no reason or motivation from the references separately that suggest the combination, as required for a proper obviousness rejection. Therefore, without a suggestion to combine, the obviousness rejection is overcome.

Claims 6, 10-12, 14, 22 and 24 Are Patentable Over Liao, Shefi And Zicker

The Examiner rejected claims 6, 10-12, 14, 22 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Liao and Shefi in view of Zicker. The Examiner uses Liao and Shefi in this rejection in the same manner as used with respect to the claims discussed above. The Examiner notes that Liao and Shefi fail to teach an alert in the system including a distinctive ringing at the recipient's station, an audible voice

message, an audible tone, providing a periodic alert, a query screen on a personal computer, warning signals throughout the call and special parameters for a particular subscriber. According to the Examiner, Zicker teaches the alerts that are missing in Liao. The Examiner concludes that the claims are obvious in view of the combination of Zicker, Shefi and Liao.

The Applicants disagree with the Examiner's conclusion. First, even assuming a combination of Zicker, Shefi and Liao is appropriate, such a combination still fails to disclose certain novel elements of the subject claims. Namely, a combination of Zicker, Shefi and Liao fails to disclose alerting a user if a transmission is received over a link "that does not send or receive private or encrypted information or that uses facilities not absolutely controlled by a network provider, as discussed above. In addition, there is no motivation to combine the references and Shefi teaches against a combination of Zicker, Shefi and Liao, as discussed above with respect to Shefi and Liao.

Claim 13 Is Not Obvious In View Of Liao and Shefi

The Examiner rejected claim 13 under 35 U.S.C. § 103(a) as being unpatentable over Liao and Shefi. According to the Examiner Liao and Shefi teach all the elements of the subject claim, except Liao and Shefi fail to teach that the system issues an alert when a previously secure route becomes insecure. The Examiner goes on to suggest that it is obvious that when a network site is insecure, the network site will be denied by the system and an alert message will be issued. This assertion is apparently not supported by a reference. The Examiner concludes that Liao and Shefi plus the Examiner's suggestion makes the claims obvious.

The Applicants disagree with the Examiner's conclusion of obviousness. The Examiner's suggestion that "it is obvious that when the network site is insecure, then the network site will be denied by the system and an alert message will be issued" is not supported by a

reference and the prior and current art generally. Indeed, the majority of network access in the current art made over the Internet is made without regard to the security of the network. The Examiner's suggestion appears to be motivated by impermissible hindsight, in light of the present invention itself. Moreover, as discussed above, Liao and Shefi fail to disclose certain novel features that are included in claim 13, namely, providing an alert to a user if a transmission is received over a link "that does not send or receive private or encrypted information or that uses facilities not absolutely controlled by a network provider. Also, there is no motivation to combine Liao and Shefi, as discussed above. Therefore, claim 13 is not obvious and is patentable.

Claim 32 Is Not Obvious In View Of Liao, Shefi And Galvin

The Examiner rejected claim 32 under 35 U.S.C. § 103(a) as being unpatentable over Liao and Shefi in view of Galvin. According to the Examiner, Liao and Shefi teach all the elements of the subject claim except that Liao and Shefi fail to teach establishing a new route between said sender and said recipient. The Examiner indicates that Galvin teaches routing such that it would have been obvious to one of skill in the art to combine Galvin, Shefi and Liao to provide the alternative route as claimed.

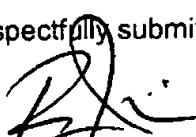
The Applicants disagree with the Examiner's conclusion of obviousness. First, even assuming a combination of Galvin, Shefi and Liao is appropriate, such a combination still fails to disclose certain novel elements of the subject claims. Namely, a combination of Galvin, Shefi and Liao fails to disclose providing an alert to a user if a transmission is received over a link "that does not send or receive private or encrypted information or that uses facilities not absolutely controlled by a network provider, as discussed above. In addition, there is no motivation to make such a combination for the reasons given above with respect to the combination of Shefi and Liao.

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CONCLUSION

All pending claims are in condition for allowance. Allowance at an early date is solicited.

Respectfully submitted,


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